

REMARKS

Claim 10 is canceled without prejudice, claims 11 to 16 are added, and claims 6 to 9 and 11 to 16 are therefore now pending.

Reconsideration is respectfully requested based on the following.

The drawings were objected to as supposedly not illustrating the features of “the navigation system comprising a drive and data medium.” The drawings objections are traversed. It is respectfully submitted that these features do not need to be shown because under 37 C.F.R. § 1.81 (a) — to which § 1.83 (a) is subject — an applicant is only “required to furnish a drawing of [the] invention where necessary for the understanding of the subject matter sought to be patented.” It is respectfully submitted that the features of the navigation system having a drive and data medium are fully described by the specification and/or would be understood by a person having ordinary skill in the art, so that drawings of these aspects are not necessary. This is especially so since the novel “pregap portion” (as provided for in the context of the presently claimed subject matter) is specifically illustrated in Figure 1. It is therefore respectfully requested that the objections be withdrawn.

Claims 6 to 10 were rejected under the second paragraph of 35 U.S.C. § 112 as being indefinite for including a purportedly “inconsistent preamble.”

While the rejections may not be agreed with, to facilitate matters, the preamble of claim 6 has been amended. Claim 10 has been canceled and new claims have been written, as explained below. It is therefore respectfully requested that the indefiniteness rejections be withdrawn.

Claims 6 to 8, and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application No. 2003/0084313 (“Tada”) in view of U.S. Patent No. 5,995,457 (“Jamail”).

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and

not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

The presently claimed subject matter and the primary reference Tada are wholly different. An important primary protective feature of claim 6, as currently presented, is the use of a pregap, which Tada is totally silent about, since it refers to selective encryption. Even if the secondary Jamail reference did generally disclose recording data in the pregap, it does not disclose the feature “where identification information is stored in a pregap of the data medium, the drive being configured to read the identification information in the pregap”, as provided for in the context of the presently claimed subject matter. In particular, the secondary Jamail reference may refer to “hidden data” and “a concealed track,” but it does not disclose *identification information stored in a pregap* as provided for in the context of the presently claimed subject matter.

Additionally, the combination of Jamail and Tada is not proper, as presented. The Supreme Court has made it clear that it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. (*See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007)). Even if the Tada reference did refer to some information as being encrypted, it does not even mention hiding or concealing that encrypted information, as provided for in the context of the presently claimed subject matter. The Jamail reference does not even mention security, copyright protection, or any other related aspect of the presently claimed subject matter. As such, a person of ordinary skill in the art would simply have no reason to combine these references, as they have no common aspects that would lead someone to make this combination.

New claims 11 to 16 do not add any new matter and are supported by the present application, including the specification.

Claims 11 and 13 include features like those of claim 6, and they are therefore allowable for essentially the same reasons, as are their respective dependent claims. Claim 16 depends from claim 6 and it is therefore allowable for the same reasons.

Additionally, as further regards claim 13, neither reference discloses the features of “checking the pregap for a condition” and “reading the navigation data if the condition is met and denying a read of the navigation data if the condition is not met.” The Jamail reference does not disclose a pregap storing copyright information, as provided for in the context of claim 13, or the feature of “checking the pregap for a condition,” and providing access to the main portion data as a result. Accordingly, claim 13 is allowable for these further reasons, as are its dependent claims.

Claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application No. 2003/0084313 (“Tada”) in view of U.S. Patent No. 5,995,457 (“Jamail”), and in further view of U.S. Patent No. 6,081,897 (“Bersson”).

The third-level Bersson reference does not cure – and is not asserted to cure -- the deficiencies of the primary reference as to claim 6, so that claim 9, which depends from claim 6, is allowable for at least the same reasons.

As further regards all of the obviousness rejections, any Official Notice is respectfully traversed to the extent that it is maintained and it is requested that the Examiner provide specific evidence to establish those assertions and/or contentions that may be supported by the Official Notices under 37 C.F.R. § 1.104(d)(2) or otherwise. In particular, it is respectfully requested that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions. This is because the § 103 rejections are apparently being based on assertions that draw on facts within the personal knowledge of the Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. (See also MPEP § 2144.03).

Accordingly, claims 6 to 9 and 11 to 16 are allowable.

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Reply to Office Action of June 8, 2009

CONCLUSION

In view of the foregoing, all of the pending claims are allowable. It is therefore respectfully requested that the rejections and objections be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

Respectfully submitted,

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By: _____

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